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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,283	11/14/2003	Eric Garland	34443.3	2048

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EXAMINER
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RAYYAN, SUSAN F

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/714,283

**Applicant(s)**

GARLAND ET AL.

**Examiner**

Susan F. Rayyan

**Art Unit**

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16, 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 9-16 are pending.
2. Claims 1-8, 17-23, 31-34 have been withdrawn from consideration.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 9-12, 15-16, 24--28 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900).**

#### **As per independent claim 9 Dutta teaches:**

a computer coupled to the network at fig.4, paragraph 70;  
a database coupled to the computer at fig.4, paragraph 70 (client rating database);  
a query device adapted to request a library of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;  
and a transfer device adapted to transfer the plurality of libraries of shared files from the computer to the database at paragraph 60, lines 1-4.

Dutta does not explicitly teach passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9. It would have been obvious to one of ordinary skill in the art

Art Unit: 2167

at the tie of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

**As per claim 10** same as claim arguments above and Dutta teaches:  
further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

**As per claim 11** same as claim arguments above and Dutta teaches:  
further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of libraries at paragraph 71(client ratings database).

**As per claim 12** same as claim arguments above and Dutta teaches:  
further comprising an inventory processing server coupled to the database at paragraph 71.

**As per claim 15** same as claim arguments above and Dutta teaches:  
the computer further comprising an interception device adapted to make a copy of a plurality of search requests from the network at paragraph 59.

**As per claim 16** same as claim arguments above and Dutta teaches:  
the computer further comprising a second transfer device adapted to transfer the plurality of search requests from the computer to the database at paragraph 59.

**As per independent claim 24** Dutta teaches:  
coupling a computer to a database at fig.4, paragraph 70;

Art Unit: 2167

coupling the computer to the network at fig.4, paragraph 70 (client rating database);

locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;

requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;

and transferring the listing of the plurality of libraries of shared files from the computer to the database at paragraph 60, lines 1-4.

Dutta does not explicitly teach passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9. It would have been obvious to one of ordinary skill in the art at the tie of the invention to combine the cited references to make a it simple to find and exchange files (parg. 9, lines 16-17).

**As per claim 25** same as claim arguments above and Dutta teaches: further comprising adding source information to each of the listings at paragraph 71.

**As per claim 26** same as claim arguments above and Dutta teaches: wherein the source information comprises the geographic location of a computer where the library is stored at paragraph 71.

**As per claim 27** same as claim arguments above and Dutta teaches:

Art Unit: 2167

further comprising intercepting a plurality of search requests on the network, where said plurality of search requests come to said computer, and copying said plurality of search requests at paragraph 59.

**As per claim 28** same as claim arguments above and Dutta teaches:

further comprising transferring the plurality of search requests from the computer to the database at paragraph 59.

**5. Claims 13-14,29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900) in view of O'Kane (Pub. No.: US 2003/0105831).**

**As per claim 13-14** same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta and Nair do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

**As per claim 29-30** same as claim arguments above and Dutta and Nair do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine

Art Unit: 2167

the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

### ***Response to Arguments***

6. Applicant's arguments filed October 6, 2004 have been fully considered but they are not persuasive.

7. Applicant argues Dutta (US 2002/013847) does not teach gathering lists of files from a general or peer-to-peer or network however Examiner respectfully disagrees. Dutta teaches this limitation at pargs. 59-60, search results are a list of files .

8. Applicant's arguments with respect to claims 9,24 have been considered but are moot in view of the new ground(s) of rejection.

Dutta does not explicitly teach "passively" and "without any action required from any users of the plurality of computers" however Nair (US 2004/0193900) does teach this limitation at parg.9. It would have been obvious to one of ordinary skill in the art at the tie of the invention to combine the cited references to make a it simple to find and exchange files (parg. 9, lines 16-17).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

Art Unit: 2167

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dutta do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

10. Applicant argues prior art of record does not teach a database coupled to the computer and a inventory preparation server coupled to the server however Dutta teaches a database at paragraph 70, client rating database and a server at parg. 77, lines 11-13 ("client" rating server).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be



Art Unit: 2167


calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (571) 272-4117. The examiner can normally be reached M-F: 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for Official communications, (703) 746-7238 for After Final communications and (703) 746-7240 for Status inquiries and draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Susan Rayyan

  
February 4, 2005

  
Primary Examiner